

REMARKS

Reconsideration and withdrawal of the rejections of the application are requested in view of the amendments and remarks presented herein, which place the application into condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-17 and 39-41 are pending in this application. Claims 1, 39, and 41 are amended in this response. Claim 40 is hereby cancelled without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

Support for the amendments can be found, for example, in paragraphs [0009]-[0011] and [0025]-[0027] of the Application as published. No new matter is added.

It is submitted that the claims are patentably distinct over the prior art and that these claim are and were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but simply for clarification and to round out the scope of protection to which Applicant is entitled.

II. RECORDATION OF PHONE INTERVIEW

The Examiner is initially thanked for granting Applicant's attorneys a phone interview on February 24, 2010. Participants in the interview included Examiner Altrev Sykes, Examiner's Supervisor Larry Tarazano, and Applicant's representative Vivek P. Shankam. Claims 1-17, and 39-41 and the rejections in the Office Action mailed on October 27, 2009 ("the action") were discussed. The Examiners suggested amending the independent claims to include language to the effect that the instant fibre is "made of paper," and indicated that such an amendment might overcome the §103 rejections in the action.

III. REJECTIONS UNDER 35 U.S.C. § 103

Initially, Applicant submits that establishing a *prima facie* case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143. Further, in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying

the reference's teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). As stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant's disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Furthermore, the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: "[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007).

Section 103 over Boehm

Claims 1, 2, 4, 7, 13, 15, 16, 39, and 41 were rejected under Section 103(a) as allegedly being unpatentable over Boehm (U.S. Patent No. 4,897,300). This rejection is traversed at least for the following reasons.

Instant claim 1 recites:

"A security fibre **made of paper, said fibre having a front side, a rear side, a length, and a width**, wherein a plurality of regions are printed on said front and rear sides of said fibre, wherein said regions are coloured and the colours are visible only under ultra-violet light, whereby the fibre is suitable for mixing with slurry paper pulp for paper formation." (Emphasis added)

Accordingly, one embodiment of the instant invention relates to a security fibre made of paper. The fibre has a front side, a rear side, a length, and a width, and a plurality of regions are printed on the front and rear sides of the fibre.

Applicant respectfully submits that since the above claimed features breathe life and meaning into the claim and define the structure of the instant security fibre, it would be improper to ignore the claimed features when construing the claims of the present application.

As understood by the Applicant, Boehm is concerned with a security thread, which is different from the instant security fibre. Applicant respectfully submits that Boehm does not teach or suggest the above identified feature of claim 1. Specifically, Boehm fails to teach or suggest a security fibre **made of paper, said fibre having a front side, a rear side, a length, and a width**, whereby the fibre is suitable for mixing with slurry paper pulp for paper formation, as recited in instant claim 1.

Modified claim 1 is therefore patentable over Boehm and claims 2, 4, 7, 13, 15 and 16 are patentable over Boehm at least by virtue of their dependence on claim 1. Modified claims 39 and 41 are patentable over Boehm for similar reasons *mutatis mutandis* as those above.

Section 103 over Boehm in view of Kaule *et al.*

Claims 1-7, 13-16, and 39-41 were rejected under Section 103(a) as allegedly being unpatentable over Boehm in view of Kaule *et al.* (U.S. Patent No. 4,756,557). This rejection is traversed for at least the following reasons.

Applicant respectfully submits that Kaule *et al.*, like Boehm, is concerned with security threads. Kaule *et al.* does not supply the teaching that is lacking in Boehm as discussed above. Specifically, both Boehm and Kaule fail to teach or suggest a security fibre **made of paper, said fibre having a front side, a rear side, a length, and a width**, whereby the fibre is suitable for mixing with slurry paper pulp for paper formation, as recited in instant claim 1.

Since Kaule *et al.* does not supply the teaching that is lacking in Boehm as discussed above, claims 1-7, 13-16, and 39-41 are patentable over the combination of Boehm and Kaule *et al.*

IV. DEPENDENT CLAIMS

Section 103 over Boehm in view of Tillotson and Tam *et al.*

Claims 8-12 were rejected under Section 103(a) as allegedly being unpatentable over Boehm in view of Tillotson (U.S. Patent No. 3,898,035) in view of Tam *et al.* (U.S. Patent No. 7,122,248). This rejection is traversed.

Applicant respectfully submits that Tillotson is concerned with a method of treating coloured yarns, which are clearly very different from security fibres made of paper, for the manufacture of pile textiles, such as carpets, which is clearly a very different field from the manufacture of security fibre. Tillotson does not supply the teaching that is lacking in Boehm as discussed above and claims 8-12 are therefore patentable at least by virtue of their dependence on claim 1.

Section 103 over Boehm in view of Schrell

Claim 17 was rejected under Section 103(a) as allegedly being unpatentable over Boehm in view of Schrell et al. (U.S. Patent No. 5,770,110). This rejection is traversed.

Applicant respectfully submits that Schrell relates to UV-active regenerated cellulose fiber including one or more inorganic luminophors selected from the group consisting of the phosphates, tungstates, oxides, silicates and aluminates of the alkaline earth metals, of the subgroup elements or of the rare earths and the halides of the alkali and alkaline earth metals doped with one or more activators. Schrell does not supply the teaching that is lacking in Boehm as discussed above and claim 17 is therefore patentable at least by virtue of its dependence on claim 1.

Therefore, the combination of Boehm and Schrell fails to render claim 17 as obvious.

For at least the reasons provided herewith, none of the cited references render the instant claims as unpatentable. Accordingly, reconsideration and withdrawal of all Section 103 rejections are requested.

Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, and in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the action. This should, however, not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

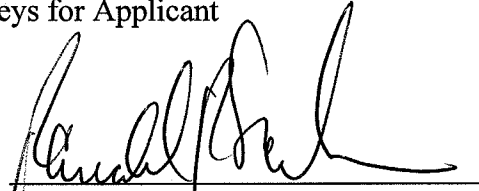
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited references, it is respectfully requested that the Examiner specifically indicate that portion, or portions, of the reference(s) providing the basis for a contrary view.

The Commissioner is authorized to charge any fee that may be required to Deposit Account No. 50-0320.

Respectfully submitted,

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